UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,441	03/09/2001	Michelle R. Lehmeier	10004872-1	6930

7590 09/13/2005

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER	
THOMPSON, JAMES A	

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/803,441	Applicant(s) LEHMEIER ET AL.	
	Examiner James A. Thompson	Art Unit 2624	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *see attached*. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1,3-14 and 18-32*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 8/15/05
13. ☐ Other: _____.

Response to Amendment

1. The proposed amendments to the claims will not be entered since the proposed amendments would require further consideration and/or further search. Additionally, the proposed amendments are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

Response to Arguments

2. Regarding page 8, lines 2-6: The Information Disclosure Statement dated 18 December 2002 has been initialed and the prior art listed therein has been fully considered.

3. Applicant's arguments filed 15 August 2005 have been fully considered but they are not persuasive.

Regarding page 8, line 7 to page 9, line 27: *Applicant argues* that (1) there is no motivation to combine the references and that (2) not all of the elements of claim 1 are taught by the references, specifically "sending the identity of the corresponding color over a network to a website."

Examiner responds that both the alleged missing element and the motivation has specifically been explained in the previous office action, dated 19 May 2005. The limitation "sending the identity of the corresponding color over a network to a website" is clearly described in Knight (US Patent 6,344,853 B1), as discussed on page 4, lines 25-29 of said previous office action. Examiner clearly stated that "Knight discloses sending color data over a network to a website (figure 3E(154) and column 10, lines 13-18 of Knight). In order for a user to be able to select color data on a website, said color data must be sent

over a network to the website." Element 154 of figure 3E of Knight shows a check box on a web site that a user clicks on to select different colors over the internet. The portion of Knight cited therein states "[s]till in step 166, the purchaser may choose among the available colors for the selected product 142, e.g., the cap 142a, by clicking on a selected one of the plurality of keys 154a-e, which correspond in one illustrative embodiment respectively to the following colors: forest green, black, ivory, khaki and navy blue."

The specific manner in which Knight is combined with Edgar in view of Ringland is given on page 5, lines 1-7 of said previous office action. Furthermore, the motivation set forth by Examiner on page 5, lines 7-11 of said previous office action states "[t]he motivation for doing so would have been to allow for a selection of a desired color from among the available colors." Thus, both the limitation "sending the identity of the corresponding color over a network to a website" and the motivation to combine Knight with Edgar (US Patent 5,598,186) in view of Ringland (US Patent 5,751,829) is clearly given in the portion of Knight cited by Examiner in said previous office action.

Additionally, the prior art references are not, as Applicant alleges, unrelated. The references have clearly been shown to be from the same field of endeavor, specifically color image data processing and color matching. This is a very narrow field of endeavor. Thus, the prior art references cited are clearly related to each other.

In response to Applicant's argument that Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on

obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Since Examiner has relied solely on the prior art references to teach the elements of claim 1, hindsight reason has clearly not been employed.

Regarding page 9, line 28 to page 10, line 7: The limitation that Applicant alleges to be lacking from Edgar and Knight, along with the motivation to combine the references, has clearly been set forth on page 21, line 3-19. The cited portion of Knight, along with the motivation to combine, is the same as discussed above regarding claim 1.

Regarding page 10, lines 8-29: A computer clearly determines a dominant color since a matched desired color (column 19, lines 38-41 and lines 56-61 of Ringland) is clearly a dominant color for the color area under consideration. Furthermore, as demonstrated on page 8, lines 18-29 of said previous office action, the full language of claim 14 is taught by a *combination* of the references and not by a simple piecemeal construction of limitations. Thus, the combination of the references as a whole, and as clearly set forth in said previous office action, must be considered when addressing the rejections instead of simply trying to tie each specific limitation to an individual reference.

Regarding page 11, line 1 to page 12, line 2: Firstly, in regard to the proposed amendments, the amendments are not entered since they are not deemed to place the application in

better form for appeal by materially reducing or simplifying the issues for appeal.

The alleged lack of a claim limitation, along with the alleged lack of motivation, has already been discussed in detail. The claim limitation specific to column 26 is taught by Knight, as discussed on page 19, line 28 to page 20, line 2 of said previous office action, and the motivation to combine has clearly been demonstrated on page 20, lines 3-12 of said previous office action. Applicant has not even attempted to address the arguments contained therein, but has continued to *merely allege* that the limitation is not taught and that there is no motivation to combine.

Further, Applicant is respectfully reminded that the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). As stated above, the motivation to combine the references has clearly been given in Knight.

Regarding page 12, lines 3-28: Applicant has clearly not considered the response Examiner gave on page 3, lines 1-12 of said previous office action in response to nearly identical arguments made by Applicant on 19 January 2005. In fact, a reading of page 10, line 16 to page 11, line 3 of Applicant's prior arguments from 19 January 2005 shows that the arguments are nearly identical in wording to the present arguments, and the substance of both arguments has not changed. Thus, Examiner

repeats the response given in said previous office action. Examiner's response given both on page 3, lines 1-12 of said previous office action and repeated below has thus far been ignored by Applicant.

"Claim 9 specifically recites 'processing said color image data signal to remove the *influence* of said texture from the color image data signal' [emphasis added]. Note that claim 9, as currently recited, does not claim that the *texture* is removed, but that the *influence* of said texture is removed. By performing the color processing based solely on the target color (column 5, lines 28-31 of Bar (US Patent 5,506,946)), and not the texture of the region (column 5, lines 31-38 of Bar), the *influence* of the texture is negated. Thus, the *influence* of the texture is removed by making the texture irrelevant to the color image data processing." [page 3, lines 1-12 of said previous office action]

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Thompson whose telephone number is 571-272-7441. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Thompson
Examiner
Art Unit 2624

JAT
23 August 2005

THOMAS D. LEE
PRIMARY EXAMINER